

## Request for Reconsideration after Final Action

The table below presents the data as entered.

| Input Field   | Entered        |
|---|----------------|
| SERIAL NUMBER   | 85379883       |
| LAW OFFICE ASSIGNED   | LAW OFFICE 110 |
| MARK SECTION (no change)  |                |
| ARGUMENT(S)   |                |
| <p>Applicant respectfully submits this Request for Reconsideration in response to the final office action, which was issued on September 26, 2013, where in the examiner refused the registration of Applicant's mark, THE JEZABELS in class 25 for "Bandanas; Belts; Blouses; Capes; Cardigans; Coats; Dresses; Footwear; Gloves; Headgear, namely, caps, baseball caps and hats; Jeans; Mittens; Overalls; Pants; Pinafores; Polo shirts; Pullovers; Rain boots; Rain coats; Rain hats; Rugby shirts; Scarves; Shawls; Shawls and head scarves; Shirts; Skirts; Suits; Sweaters; Sweatshirts; T-shirts; Ties; but excluding lingerie, underwear, sleepwear, shapewear, yoga clothing or yoga pant" on the grounds that the mark is likely to be confused with Registration Nos. 3828619, 0664456, and 3273529 for the mark JEZEBEL for "Loungewear, namely, tap pants; and shapewear, namely, bodysuits", "JEZEBEL" for "CORSETS, BRASSIERES, BANDEAUX, GIRDLES, CORSET-COMBINATIONS, AND GARTER BELTS" and JEZEBEL for "Panties, bustiers, camisoles, chemises and sleepwear", in class 25, all owned by Piege Co. (the "Piege Registrations").</p> <p>Applicant is filing a consent to register herewith, signed by Applicant and the owner of the Piege Registrations (the "Consent Agreement").</p> <p>In the Consent Agreement, the owner of the Piege Registrations consents to Applicant's use and registration of THE JEZABELS mark in International Class 25 in connection with "Bandanas; Belts; Blouses; Capes; Cardigans; Coats; Dresses; Footwear; Gloves; Headgear, namely, caps, baseball caps and hats; Jeans; Mittens; Overalls; Pants; Pinafores; Polo shirts; Pullovers; Rain boots; Rain coats; Rain hats; Rugby shirts; Scarves; Shawls; Shawls and head scarves; Shirts; Skirts; Suits; Sweaters; Sweatshirts; T-shirts; Ties; but excluding lingerie, underwear, sleepwear, shapewear, yoga clothing or yoga pant". The Consent Agreement sets forth the parties' acknowledgements that due, in part, to the differences in the marks overall commercial impressions, differences in the parties' respective goods and services, channels of trade, and consumers, there is no likelihood of confusion in the marketplace.</p> <p>The Federal Circuit has consistently stated that consent agreements are to be accorded great weight. In <i>Bongrain International (American) Corp. v. Delice de France Inc.</i>, 811 F.2d 1479, 1484-85, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987), the Court stated as follows: "We have often said, in trademark cases involving agreements reflecting parties' views on the likelihood of confusion in the marketplace, that they are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending on the circumstances, carry great weight, as was held in</p> |                |

*duPont.”*

In light of the foregoing, Applicant respectfully requests that Applicant's Mark be allowed to pass to publication.

## EVIDENCE SECTION

### EVIDENCE FILE NAME(S)

|   |  |
|---|--|
| <b>ORIGINAL PDF FILE</b>                  | <a href="#">evi_3812512210-154036015_.Class_25_consent.pdf</a>                 |
| <b>CONVERTED PDF FILE(S)</b><br>(4 pages) | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\853\798\85379883\xml13\RFR0002.JPG</a> |
|   | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\853\798\85379883\xml13\RFR0003.JPG</a> |
|   | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\853\798\85379883\xml13\RFR0004.JPG</a> |
|   | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\853\798\85379883\xml13\RFR0005.JPG</a> |
| <b>DESCRIPTION OF EVIDENCE FILE</b>       | A consent agreement between Applicant and the owner of the Cited Marks         |

## SIGNATURE SECTION

|                                       |   |
|---------------------------------------|---|
| <b>RESPONSE SIGNATURE</b>             | /safiaaanand/                           |
| <b>SIGNATORY'S NAME</b>               | Safia A. Anand                          |
| <b>SIGNATORY'S POSITION</b>           | Attorney of Record, NY State Bar Member |
| <b>SIGNATORY'S PHONE NUMBER</b>       | 212-451-2300                            |
| <b>DATE SIGNED</b>                    | 03/25/2014                              |
| <b>AUTHORIZED SIGNATORY</b>           | YES                                     |
| <b>CONCURRENT APPEAL NOTICE FILED</b> | YES                                     |

## FILING INFORMATION SECTION

|                    |  |
|--------------------|--|
| <b>SUBMIT DATE</b> | Tue Mar 25 15:52:58 EDT 2014   |
| <b>TEAS STAMP</b>  | USPTO/RFR-38.125.122.10-2<br>0140325155258851354-85379<br>883-50016dc1016806a755bcf<br>e17dab113ce56be564ab5ccbe<br>18de6fb8ad11b288f2fdb-N/A<br>-N/A-20140325154036015224 |

## **Request for Reconsideration after Final Action To the Commissioner for Trademarks:**

Application serial no. **85379883** has been amended as follows:

### **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

Applicant respectfully submits this Request for Reconsideration in response to the final office action, which was issued on September 26, 2013, where in the examiner refused the registration of Applicant's mark, THE JEZABELS in class 25 for "Bandanas; Belts; Blouses; Capes; Cardigans; Coats; Dresses; Footwear; Gloves; Headgear, namely, caps, baseball caps and hats; Jeans; Mittens; Overalls; Pants; Pinafores; Polo shirts; Pullovers; Rain boots; Rain coats; Rain hats; Rugby shirts; Scarves; Shawls; Shawls and head scarves; Shirts; Skirts; Suits; Sweaters; Sweatshirts; T-shirts; Ties; but excluding lingerie, underwear, sleepwear, shapewear, yoga clothing or yoga pant" on the grounds that the mark is likely to be confused with Registration Nos. 3828619, 0664456, and 3273529 for the mark JEZEBEL for "Loungewear, namely, tap pants; and shapewear, namely, bodysuits", "JEZEBEL" for "CORSETS, BRASSIERES, BANDEAUX, GIRDLES, CORSET-COMBINATIONS, AND GARTER BELTS" and JEZEBEL for "Panties, bustiers, camisoles, chemises and sleepwear", in class 25, all owned by Piege Co. (the "Piege Registrations").

Applicant is filing a consent to register herewith, signed by Applicant and the owner of the Piege Registrations (the "Consent Agreement").

In the Consent Agreement, the owner of the Piege Registrations consents to Applicant's use and registration of THE JEZABELS mark in International Class 25 in connection with "Bandanas; Belts; Blouses; Capes; Cardigans; Coats; Dresses; Footwear; Gloves; Headgear, namely, caps, baseball caps and hats; Jeans; Mittens; Overalls; Pants; Pinafores; Polo shirts; Pullovers; Rain boots; Rain coats; Rain hats; Rugby shirts; Scarves; Shawls; Shawls and head scarves; Shirts; Skirts; Suits; Sweaters; Sweatshirts; T-shirts; Ties; but excluding lingerie, underwear, sleepwear, shapewear, yoga clothing or yoga pant". The Consent Agreement sets forth the parties' acknowledgements that due, in part, to the differences in the marks overall commercial impressions, differences in the parties' respective goods and services, channels of trade, and consumers, there is no likelihood of confusion in the marketplace.

The Federal Circuit has consistently stated that consent agreements are to be accorded great weight. In *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1484-85, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987), the Court stated as follows: "We have often said, in trademark cases involving agreements reflecting parties' views on the likelihood of confusion in the marketplace, that they are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending on the circumstances, carry great weight, as was held in *duPont*."

In light of the foregoing, Applicant respectfully requests that Applicant's Mark be allowed to pass to publication.

### **EVIDENCE**

Evidence in the nature of A consent agreement between Applicant and the owner of the Cited Marks has been attached.

**Original PDF file:**

[evi\\_3812512210-154036015\\_.Class\\_25\\_consent.pdf](#)

**Converted PDF file(s) (4 pages)**

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /safiaaanand/ Date: 03/25/2014

Signatory's Name: Safia A. Anand

Signatory's Position: Attorney of Record, NY State Bar Member

Signatory's Phone Number: 212-451-2300

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85379883

Internet Transmission Date: Tue Mar 25 15:52:58 EDT 2014

TEAS Stamp: USPTO/RFR-38.125.122.10-2014032515525885

1354-85379883-50016dc1016806a755bcfe17da

b113ce56be564ab5ccbe18de6fb8ad11b288f2fd

b-N/A-N/A-20140325154036015224

March 19, 2014

**VIA ELECTRONIC FILING**


Re: CONSENT TO REGISTER

Mark: THE JEZABELS  
Serial No.: 85/379,883

To Whom It May Concern:

Piege Co. ("Piege") and The Jezabels Band Pty Ltd. ("The Jezabels") hereby agree as follows:

1. Piege is the owner of the trademark registrations for the following marks in Class 25:

| MARK  | Registration No. | Goods  |
|---|------------------|--|
| "JEZEBEL"   | 0664456          | CORSETS, BRASSIERES, BANDEAUX, GIRDLES, CORSET-COMBINATIONS, AND GARTER BELTS.   |
| JEZEBEL   | 3828619          | Loungewear, namely, tap pants; and shapewear, namely, bodysuits  |
| JEZEBEL   | 3273529          | Panties, bustiers, camisoles, chemises and sleepwear   |
|  | 4240531          | bras, panties, bustiers, camisoles, chemises, corsets, bandeaux, garter belts, sleepwear, loungewear, namely, tap pants and shape wear, namely, bodysuits. |
| JEWELS BY JEZEBEL   | 4299206          | lingerie, bras, panties, camisoles, baby doll pajamas, garter belts, chemises and bustiers   |

2274139-2



Error! Unknown document property name.



The foregoing marks are collectively referred to as the "Piege Jezebel Registrations" or the "Piege Jezebel Marks". Piege or its predecessors-in-interest have used one or more of the Piege Jezebel Marks in the United States since at least as early as 1957.

2. The Jezabels are a well-known Australian band that has been in existence since 2007. The band's first released music in February 2009. The band's first live appearance in the United States was in October 2010.

3. One or more of the Piege Jezebel Registrations have been cited as a bar to the registration of the mark THE JEZABELS (the "THE JEZABELS Mark"), Serial No. 85/379,883, in the name of The Jezabels, initially covering the following goods: "Bandanas; Belts; Blouses; Capes; Cardigans; Coats; Dresses; Dressing gowns and bath robes; Fleece tops; Footwear; Gloves; Headgear, namely, caps, baseball caps and hats; Jeans; Jogging suits; Leggings; Leotards; Mittens; Nightgowns; Overalls; Pajamas; Pants; Pinafores; Polo shirts; Pullovers; Rain boots; Rain coats; Rain hats; Rugby shirts; Scarves; Shawls; Shawls and headscarves; Shirts; Shorts; Skirts; Socks; Stockings; Suits; Sweaters; Sweatpants; Sweatshirts; Swimwear; T-shirts; Ties; Underwear; Vests" in Class 25.

4. In response to a previous office action, The Jezabels amended the description of goods in their pending Class 25 application to differentiate their goods from those expressly set forth in the Piege Jezebel Registrations, namely the amended description covered the following goods: "Bandanas; Belts; Blouses; Capes; Cardigans; Coats; Dresses; Footwear; Gloves; Headgear, namely, caps, baseball caps and hats; Jeans; Mittens; Overalls; Pants; Pinafores; Polo shirts; Pullovers; Rain boots; Rain coats; Rain hats; Rugby shirts; Scarves; Shawls; Shawls and headscarves; Shirts; Skirts; Suits; Sweaters; Sweatshirts; T-shirts; Ties" in Class 25.

5. Pursuant to an agreement with Piege, The Jezabels have further amended their pending Class 25 application to add the following italicized language to their description of goods: "Bandanas; Belts; Blouses; Capes; Cardigans; Coats; Dresses; Footwear; Gloves; Headgear, namely, caps, baseball caps and hats; Jeans; Mittens; Overalls; Pants; Pinafores; Polo shirts; Pullovers; Rain boots; Rain coats; Rain hats; Rugby shirts; Scarves; Shawls; Shawls and headscarves; Shirts; Skirts; Suits; Sweaters; Sweatshirts; T-shirts; Ties; *but excluding lingerie, underwear, sleepwear, shapewear, yoga clothing or yoga pant*" (the "Jezabels Goods").

6. The Jezabels currently use the THE JEZABELS Mark in connection with the Jezabels Goods in the United States and have done so since October 2010. Products bearing THE JEZABELS Mark are currently sold only at concerts held by The Jezabels and on the band's online store: <http://thejezabels.com/>.

7. Piege uses the Piege Jezebel Marks in connection with lingerie, other goods set forth in the Piege Jezebel Registrations and related goods (the "Piege Goods"). The Piege Goods are sold at department stores, specialty lingerie stores, other retail outlets and on their website:

2274139-2



Error! Unknown document property name.

[www.jezebelusa.com](http://www.jezebelusa.com) and other websites. Thus, the channels of trade for the Jezabels Goods and the Piege Goods are different.

8. The Jezabels have agreed to use THE JEZABELS Mark only in a manner that is not confusingly similar to the Piege Jezebel Marks, namely The Jezabels will, in relation to clothing items, use THE JEZABELS Mark only in relation to the Jezabels Goods and only on the outer side or outside of such Jezabels Goods; they will not use THE JEZABELS Mark on hangtags or labels; and they will not use logos that are substantially identical with or deceptively similar to the following Piege logos:



9. The parties do not believe that THE JEZABELS Mark and the Piege Jezebel Marks, when used in connection with the goods as defined in their respective applications and registrations and as used as set forth herein, are likely to be confused by consumers as their respective such goods are different and the disparate nature of the channels of trade and clientele to whom the parties' respective such goods are marketed and sold are different. In addition, THE JEZABELS Mark and the Piege Jezebel Marks have co-existed in the marketplace since October 2010, and the parties are unaware of any confusion between their respective uses of their marks.

10. The Jezabels shall use THE JEZABELS Mark in a manner calculated to avoid confusion and will cooperate with Piege in taking any and all reasonable actions to avoid confusion. In the event either of the parties becomes aware of, or is informed of, confusion arising from the use of their respective marks on their respective goods/services, they will promptly inform one another of it and The Jezabels will promptly, and in good faith, confer and cooperate with Piege to take appropriate steps to eliminate or minimize such confusion.

11. The parties agree and acknowledge that it is unlikely that the concurrent use in accordance herewith of THE JEZABELS Mark, as applied to the Jezabels Goods, and the Piege Marks, as applied to the Piege Goods, will create confusion among consumers as to the source, origin or sponsorship of the parties' respective such goods.

12. Likelihood of confusion is unlikely due to the different nature of the parties' respective such goods to be rendered under THE JEZABELS Mark and the Piege Jezebel Marks, the different sales channels, class of customers and means employed to sell the said goods. Additionally, the marks have coexisted without known confusion for almost three years.



2274139-2

Error! Unknown document property name.

13. Based on the foregoing, (a) Piege consents to the registration of THE JEZABELS Mark in Class 25, Serial No. 85/379,883, for the Jezabels Goods, and (b) The Jezabels hereby consent to the use and registration by Piege of the mark JEZEBEL and any other mark consisting of or containing the word JEZEBEL in connection with any goods in Class 25.

Agreed:

PIEGE CO.

By: 

Name: Robert Zarabi  
Title: President/CEO

THE JEZABELS BAND PTY LTD.

By: 

Name: Sam Lockwood  
Title: Director

2274139-2

Error! Unknown document property name.